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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,020	06/01/2005	Paolo Balliello	PL/2-22807/A/PCT	8510
324	7590	07/08/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			ABU ALL SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
			NOTIFICATION DATE	DELIVERY MODE
			07/08/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/537,020

Applicant(s)

BALLIELLO, PAOLO

Examiner

SHUANGYI ABU ALI

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-22 remain for examination, claim 10 is canceled.

Claim Rejections - 35 USC § 103

The rejection of claims 1-5, 7, 9, 12-13, and 19-22 under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,264,552 to McMahon et al, in combination with U.S. Patent No. 2,618,632 to Klug et al. as generally set forth in the previous office action mailed 12/09/2008 stands.

The rejection of claim 6, 11, 14-18 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Macmahon et al. and Klug et al. , further in view of U. S. Patent No. 3,728,143 to Pollard et al. as generally set forth in the previous office action mailed 12/09/2008 stands.

The rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Macmahon et al. and Klug et al. et al, further in view of U. S. patent No. 5,082,498 to Kurtz et al. as generally set forth in the previous office action mailed 12/09/2008 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

Response to Arguments

Applicant's arguments filed 03/11/2009 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-9 and 11-22 as indicated in the previous Office Action stand.

Applicant argues that the Klug disclose the cellulose ether contains hydroxyl ethyl group and carboxymethyl group, which in the examples contain a halide in the alkyl chain. The Examiner respectfully submits that the claims fail to disclose that the R1 is an unsubstituted group. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the unsubstituted group) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the previous submitted declaration is not need to show all embodiments of the invention. The Examiner respectfully submits that to establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside (i.e. as well as the upper and lower limits) the claimed range to show the criticality of the claimed range. *In re Hill* 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

Applicant argues that there is no motivation to combine MacMahon and Klug. The Examiner respectfully submits that McMahon et al. disclose a composition

comprising organic pigments and an additive system, which comprises comprising a binder and an application agent. The binder can be cellulose derivatives or PVA. The application agents can be fatty acid, fatty alcohol and amines with 12-20 carbon atoms. The amount of the additive system is about 0.5-20% by weight based on the weight of the pigment. The amount of the binder based on the additive system can be about 5%. (col. 1, line 65 to col. 4, line 10 and examples). Therefore the amount of the application agent amount can be less than about 95%. Klug, also drawn to cellulose derivatives being used as binder, discloses that cellulose ether with the degree of substitution as applicants set forth in the instant application has good compatibility with various basic materials such as amines. (col. 7, lines 65-75). Applicant argues that both MacMahon and Klug fail to disclose the instant application alone. The Examiner respectfully submits that that is the reason the rejection based on U. S. C. 103 is used to reject the instant application. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that MacMahon disclose in the examples that the amount of the pigment being used is less than the amount of the pigment being used in the instant application. The Examiner respectfully submits that the amount of the additive system is about 0.5-20% by weight based on the weight of the pigment, which overlaps the amount defined by the instant application. While the reference does not provide a

specific example which falls within the instant claims, it should be noted that "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See In re Van Marter et al 144 USPQ 421; In re Windmer et al 147 USPQ 518, 523; and In re Chapman et al 148 USPQ 711.

Since the rejection of claims 1-5,7,9,12,13 and 19-22 are valid under the combined teaching of MacMahon and Klug, the rejection of claims 6, 8, 11, and 14-18 as generally set forth in the previous office action mailed 12/09/2008 stands.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

/S. A./
Examiner, Art Unit 1793